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Filing date: **07/02/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91208141
Party	Defendant MARQUEZ BROTHERS INTERNATIONAL, INC.
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Date	07/02/2013
Attachments	Amended Answer.pdf(2141188 bytes)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Trademark Application:

Serial No.: 85/430918
Filed: September 23, 2011
Mark: CASERA

GOYA FOODS, INC.

Opposer,

v.

MARQUEZ BROTHERS
INTERNATIONAL, INC.

Applicant.

Opposition No. 91208141

APPLICANT'S AMENDED ANSWER TO
NOTICE OF OPPOSITION

13 Applicant, Marquez Brothers International, Inc., a California corporation with a principal
14 business address of 5801 Rue Ferrari, San Jose, CA 95138, hereby amends its answer to the
15 Notice of Opposition of Goya Foods, Inc. as follows:

16 1. Applicant admits that U.S. Patent and Trademark Office records list Goya Foods, Inc. as
17 the current owner of trademark registrations for CASERITA and CASERA for chicken
18 croquettes and processed vegetables respectively. Applicant lacks sufficient information to
19 enable it to form a belief as to the truth of the remaining allegations of Paragraph 1 of the Notice
20 of Opposition, and on that basis denies same.

21 2. Applicant denies that its chorizo, longaniza, deli meats, namely, hams, turkey are
22 substantially identical to or generally related to Opposer's chicken croquettes or processed
23 vegetables. Applicant lacks sufficient information to enable it to form a belief as to the truth of
24 the remaining allegations of Paragraph 2 of the Notice of Opposition, and on that basis denies
25 same.

26 3. Applicant admits that U.S. Patent and Trademark Office records list Goya Foods, Inc. as
27 the current owner of trademark registrations for CASERITA and CASERA for chicken

croquettes and processed vegetables respectively. Applicant lacks sufficient information to enable it to form a belief as to the truth of the remaining allegations of Paragraph 3 of the Notice of Opposition, and on that basis denies same.

4. Applicant lacks sufficient information to enable it to form a belief as to the truth of the allegations of Paragraph 4 of the Notice of Opposition, and on that basis denies same.

5. Applicant admits that U.S. Patent and Trademark Office records indicate that Reg. No. 2,740,494 for CASERA for processed vegetables and Reg. No. 3,040,516 for CASERITA for chicken croquets are incontestable and that Goya Foods, Inc. is listed as the current owner thereof.

6. Applicant lacks sufficient information to enable it to form a belief as to the truth of the allegations of Paragraph 6 of the Notice of Opposition, and on that basis denies same.

7. Applicant lacks sufficient information to enable it to form a belief as to the truth of the allegations of Paragraph 7 of the Notice of Opposition, and on that basis denies same.

8. Applicant lacks sufficient information to enable it to form a belief as to the truth of the allegations of Paragraph 8 of the Notice of Opposition, and on that basis denies same.

9. Applicant lacks sufficient information to enable it to form a belief as to the truth of the allegations of Paragraph 9 of the Notice of Opposition, and on that basis denies same.

10. Applicant lacks sufficient information to enable it to form a belief as to the truth of the allegations of Paragraph 10 of the Notice of Opposition, and on that basis denies same.

11. Applicant lacks sufficient information to enable it to form a belief as to the truth of the allegations of Paragraph 11 of the Notice of Opposition, and on that basis denies same.

12. [10.] Applicant denies the allegations of Paragraph 12 (incorrectly numbered as Paragraph 10) of the Notice of Opposition.

13. [11.] Applicant denies that its CASERA mark is confusingly similar to Opposer's CASERITA or CASERA marks.

14. [12.] Applicant admits that the term "caserita" in the Spanish language is the diminutive equivalent of the term "casera". By way of a further answer, "casera" is the feminine

1 form of the masculine adjective “casero,” both meaning “domestic” or “homemade”.

2 15. [13.] Applicant denies that its chorizo, longaniza, deli meats, namely, hams, turkey are
3 substantially related in part or generally related in part to Opposer’s chicken croquettes or
4 processed vegetables. Applicant admits that its use of CASERA in connection with its goods is
5 without the consent or permission of Opposer. Applicant does not require consent or permission
6 from Opposer to use its CASERA mark.

7 16. [14.] Applicant denies the allegations of Paragraph 16 (incorrectly numbered as
8 Paragraph 14) of the Notice of Opposition.

9 17. [15.] Applicant lacks sufficient information to enable it to form a belief as to the truth
10 of the allegations of Paragraph 17 (incorrectly numbered as Paragraph 15) of the Notice of
11 Opposition, and on that basis denies same.

12 18. [16.] Applicant lacks sufficient information to enable it to form a belief as to the truth
13 of the allegations of Paragraph 18 (incorrectly numbered as Paragraph 16) of the Notice of
14 Opposition, and on that basis denies same.

15 19. [17.] Applicant denies the allegations of Paragraph 19 (incorrectly numbered as
16 Paragraph 17) of the Notice of Opposition.

17 20. [18.] Applicant denies the allegations of Paragraph 20 (incorrectly numbered as
18 Paragraph 18) of the Notice of Opposition.

19 21. [19.] Applicant denies the allegations of Paragraph 21 (incorrectly numbered as
20 Paragraph 19) of the Notice of Opposition.

21 AFFIRMATIVE DEFENSES

22 1. As a first affirmative defense, Opposer has acquiesced to Applicant’s use of the mark at
23 issue.

24 i. With regard to Applicant’s first affirmative defense, the following facts apply:

25 ii. On January 13, 1994, Applicant filed for CASERO (RN: 1,934,691) for “cheese”
26 in Class 29, which registered November 14, 1995. The registration lists a first use date of March
27 31, 1977 and first use in commerce June 30, 1987.

iii. On August 8, 2002, Opposer filed for CASERA (RN: 2,740,494) for “processed vegetables” in Class 29, which registered July 22, 2003. The registration lists a first use date of January 1979 and first use in commerce January 8, 1990.

iv. On June 14, 2004, Opposer filed for CASERITA (RN: 3,040,516) for “chicken croquettes” in Class 29, which registered January 10, 2006. The registration lists first use and first use in interstate commerce October 19, 1972.

v. On April 22, 2008, Applicant filed for CASERA (RN: 3,720,632) for “cheese and dairy products excluding ice cream, ice milk and frozen yogurt” in Class 29 and “flour, corn flour, instant corn flour mix” in Class 30, which registered December 8, 2009. The registration identifies dates of first use of September 30, 1994 for Class 29 and December 6, 2002 for Class 30. Opposer did not oppose or object to Applicant’s application for and registration of CASERA in association with products in Classes 29 and 30.

vi. Applicant's and Opposer's CASERO, CASERA and CASERITA marks have coexisted for more than thirty years without Opposer's objection or complaint. Opposer has had notice of Applicant's use and ownership of CASERO and CASERA marks and had an opportunity to object to such use and registration for goods in Classes 29 and 30.

vii. Further, evidence of Opposer acquiescing to Applicant's use of the CASERA mark stems from Opposer's "OPPOSER/COUNTERCLAIM DEFENDANT'S MOTION FOR SUMMARY JUDGMENT DISMISSING APPLICANT'S COUNTERCLAIMS IN THEIR ENTIRETIES" filed in Opposition number 91198986. *See* Exhibit A. During the course of Opposition No. 91198986, regarding Opposer's objection to the mark LA CASERA owned by Ole Mexican Foods, Inc., Opposer's counsel cited Applicant's CASERA and CASERO marks (among a number of other similar marks) as evidence supporting Opposer's position in its summary judgment motion. Opposer referenced Applicant's registrations to support its stance that the terms "casero" and "casera" have been translated differently by trademark owners in association with *many* applications to register identical or similar marks. Opposer's counsel acknowledges multiple CASERA and CASERO formative marks for a spectrum of goods

1 accompanied by variant definitions to prove its point. Where and when convenient and
2 beneficial to its own interest, Opposer is on record acknowledging Applicant's (and other) marks
3 to support its own arguments in front of the Board. The extended coexistence of the marks at
4 issue, coupled and enhanced by Opposer's use of Applicant's registrations for CASERA and
5 CASERO to support its own arguments in front of the Board evidences that Opposer
6 affirmatively knew of Applicant's long-standing use of the mark at issue, engaged in misleading
7 conduct leading Applicant to reasonably infer that Opposer's rights in the CASERA and
8 CASERITA marks would not be asserted against Applicant, and Applicant relied on such
9 assurances in filing the present application and will be materially prejudiced if the delayed
10 assertion of such rights is permitted.

11 2. As a second affirmative defense, Opposer is estopped from asserting any claims against
12 Applicant arising out of the matters alleged in the Notice of Opposition.

13 i. Applicant incorporates herein by reference, as though fully set forth, Affirmative
14 Defenses paragraphs 2(i) through 2(vii) above.

15 ii. The extended coexistence of the marks at issue, coupled and enhanced by
16 Opposer's use of Applicant's registrations for CASERA and CASERO to support its own
17 arguments in front of the Board evidences that Opposer has engaged in misleading conduct
18 leading Applicant to reasonably infer that Opposer's rights in the CASERA and CASERITA
19 marks would not be asserted against Applicant, Applicant relied upon this conduct, and, due to
20 this reliance, Applicant will be materially prejudiced if the delayed assertion of such rights is
21 permitted.

22 3. As a third affirmative defense, there is no likelihood of consumer confusion, mistake or
23 deception between Opposer's CASERITA or CASERA marks and Applicant's CASERA mark,
24 as evidenced by the Parties' concurrent use of their respective marks in connection with Class 29
25 goods. Opposer states that it has used its CASERA mark since 1979 and its CASERITA mark
26 since 1972. Applicant began use of its CASERO mark in 1977 in connection with cheese and is
27 the owner of incontestable Reg. No. 1,934,691 for CASERO for cheese in class 29. Applicant

1 began use of its CASERA mark in 1994 in connection with cheese and dairy products and in
2 2002 for flour, corn flour, instant corn flour mix and is the owner of Reg. No. 3,720,632 for
3 CASERA for same in classes 29 and 30. In the more than thirty years of concurrent use of the
4 parties' respective CASERA, CASERO, and CASERITA marks there has been no evidence of
5 confusion, deception or mistake among consumers or others.

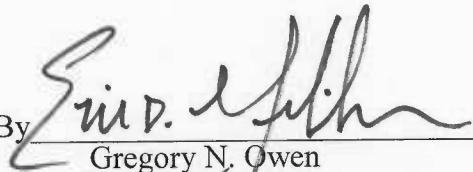
6 WHEREFORE, Applicant requests that the Notice of Opposition be denied in all respects
7 and the application be approved for registration.

8 Dated: July 2, 2013

Respectfully submitted,

OWEN, WICKERSHAM & ERICKSON, P.C.

11 By



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EXHIBIT A

ESTTA Tracking number: **ESTTA510380**

Filing date: **12/11/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91198986
Party	Plaintiff Goya Foods, Inc.
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Date	12/11/2012
Attachments	Motion Sum Judgment 12-11-12.pdf (20 pages)(113875 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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Goya Foods, Inc.

Opp. No. 91198986

Opposer

Mark: LA CASERA

v.

Ser. No.: 77924022

Olé Mexican Foods, Inc.,

Applicant

-----X

**OPPOSER/COUNTERCLAIM DEFENDANT'S
MOTON FOR SUMMARY JUDGMENT
DISMISSING APPLICANT'S COUNTERCLAIMS
IN THEIR ENTIRETIES**

On the Brief:

John M. Rannells
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Attorneys for Goya Foods, Inc. (Opposer/Counterclaim Defendant)

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Applicant is allowed until **July 21, 2012** to inform the Board how it wishes to proceed with respect to the counterclaim, failing which, the counterclaim will go forward and the appropriate dates will be reset.

Applicant did not inform the Board of anything, and accordingly, on September 7, 2012 the Board resumed proceedings with regard to Applicant's counterclaims. Applicant's attorneys have corresponded with Opposer's attorneys and are apparently proceeding with the counterclaims. As demonstrated below, the counterclaims are all without merit.

II. ARGUMENT

A. Applicant's First Counterclaim – Fraud (Mistranslation of Mark)

While the counterclaim is titled "Fraud – Mistranslation of Mark" it appears to include two additional allegations, the three alleged fraud claims being (i) that Goya's translation of the mark CASERA as "homelike" was a deliberate mistranslation to avoid a descriptiveness refusal; (ii) that Goya misdescribed its goods (namely as "processed vegetables" instead of as one processed vegetable – canned black beans, or possibly claiming that beans are not vegetables, the claim is vague), and (iii) that it was not using the mark on "processed vegetables" at the time of its application and/or at the time of filing its 8&15 affidavits. All of the Applicant's allegations, which are alleged "upon information and belief" are without merit or basis.

(i) Mistranslation of Mark

The Applicant's claim in this regard is based upon ¶¶ 26, 27, 33, 34, 35, 38, and 39 of Applicant's First Counterclaim, which assertions may be summarized as follows: (1) Goya, in response to Examiner request translated the term "Casera" as "homelike," (2) The Examiner approved the application without a descriptiveness or genericness refusal, (3) "upon information and belief," "casera" is an adjective applied to feminine nouns, (4) "upon information and belief," "casera" as applied to food products is translated and understood by Spanish-speaking

consumers to mean “home-made” or “home-style,” and not “homelike,” (5) “upon information and belief,” the Trademark Office routinely requires applicants to disclaim rights in the words “home-made” or “home-style” in connection with food products, (6) Goya knew that CASERA is correctly translated as “home-made,” and (7) Goya’s mistranslation was a material misrepresentation made with the intent of inducing the Trademark Office to grant the registration.

The claim of fraud is without merit, as demonstrated below.

In Applicant’s First Counterclaim, Applicant takes the inaccurate and self-serving position that the only permissible definition of “casera” is “homemade” or “home-style.” The best evidence of the meaning of the term “casera,” however, is the dictionary. As evidenced below, the term, standing alone, can be either a noun or an adjective and it has a number of different but related meanings.

Pocket Oxford Spanish Dictionary, 3rd Ed.

casero –**ra** *adj.* **(a)** homemade; amateur; domestic **(b)** home-loving *m.f* **(a)** (propietario) *(m)* landlord; *(f)* landlady **(b)** caretaker, customer, storekeeper, stallholder.

VOX Compact Spanish and English Dictionary

casero, ra *a.* homely; domestic, informal [dress, etc]. 2 home-made. 3 home-loving. 4 *m.-f.* landlord, landlady. 5 renter, tenant.

Junior Classic Dictionaries, Spanish-English and English Spanish

casero, sm. Landlord; -, **ra**, *a.* domestic; familiar; housekeeping.
[*a.* = adjective; sm. = masculine substantive]

SpanishD!ct (www.spanishdict.com.translate/casera)

casera / adjective

1. Domestic, homely, in a family way
2. Home-bred
3. Customer, client

www.langtolang.com

casera - landlady

Langenscheidt Pocket Spanish Dictionary

casero 1. Domestic, household; home-made; homespun; home-loving; 2. *m, a f* landlord; caretaker.

See, the accompanying declaration of Conrad Colon, namely, Colon Decl. ¶ 13, Ex. 5.

As further stated by Mr. Colon¹, at ¶¶ 14-16 of his declaration, and based upon his fluency in both Spanish and English, the term “casera” standing alone can be either a noun or an adjective and would be perceived as both by Spanish speaking consumers; and the English word “homelike” is a proper and an apt translation of the term “casera” as are the words “domestic,” “homespun,” “home-loving,” “homely,” and “home-bred.” *Id.*, at ¶15 and Ex. 5 thereto (dictionary definitions).

Further, the translation of “casera” as “homelike” came from one of Goya’s predecessors in interest in the mark, namely from Reg. No. 1835577 for the mark CASERA for processed beans and peas wherein the term was translated as “homelike.” *Id.*, at ¶16.

Given the above, the translation of “casera” as the apt term “homelike” cannot be a material misrepresentation constituting intentional fraud.

Reference is further made to the various “Casera” and “Casero” marks of record in the USPTO and to the translations set forth therein. *See*, the accompanying Rannells Decl. ¶ 4, Ex. 1 (copies of third party registrations from the TESS database for marks containing “casero” or “casera,” for food products):

85430621 CASERO Chorizo, longaniza, deli meats
The registration states: “The English translation of ‘CASERO’ in the mark is ‘Domestic’, ‘Home-Loving’ or ‘caretakers’.”

1934691 CASERO Cheese
The registration states: “The English meaning of the Spanish word ‘CASERO’ in the mark is ‘domestic’, ‘home-loving’ or ‘caretaker’s.’”

¹ Mr. Colon is fluent in Spanish and English and has well over 50 years of experience in the food industry, having worked continuously at Goya for the past fifty-four years.

0875728 CASERA Soups, tomato sauce and canned nectars and fruit Juices
The registration states: "The English translation of the Spanish word 'CASERA' is 'homelike'."

1835577 CASERA Processed beans and peas
The registration states: "The English translation of 'CASERA' means 'homelike'."

2573432 TINTO DE CASERA Mineral and carbonated waters etc.
The registration states: "The English translation of 'Tinto de Casera' is 'housekeeper's red wine'" (as suggested by the Examining Attorney in Office Action).

3720632 CASERA Cheese and dairy products, etc.
The registration states: "The English translation of 'CASERA' in the mark is 'domestic,' 'homely,' 'in a family way' or 'housekeeper'."

3603635 TRADICION CASERA Marmalade, jellies
The registration states: "The English translation of 'TRADICION CASERA' is 'Landlady's Tradition'" (as suggested by the Examining Attorney in Office Action and Examiner's reference to dictionary definition given at www.langtolang.com).

3535603 COCINA CASERA Processed foods and dairy products
and design
The registration states: "The foreign wording in the mark translates into English as 'home cooking'." The registration does not contain any disclaimers.

85535458 CASERA Chocolate milk, milk
Abandoned application, however, besides a 2(d) refusal, the Examiner required a translation and stated in the Office Action:

"English Translation Required Applicant must submit an English translation of the mark. 37 C.F.R. §2.32(a)(9); TMEP §809.

The following translation statement is suggested:

The English translation of "CASERA" in the mark is "LAND LADY" or "DOMESTIC".

See the attached definition (and the translation in the applicant's co-pending application.)

The above records are relevant evidence of the manner in which the terms "casero" and "casera" have been translated by trademark owners in association with applications to register their marks. They also evidence the Examiners' suggestions for translation of the terms. They are also relevant evidence of the lack of a disclaimer requirement.

With regard to the Applicant's claim that the Trademark Office routinely requires trademark applicants to disclaim rights in the English term "home-made" (*See*, Applicant's First Counterclaim *at* ¶35): Attached to the accompanying Rannells Declaration *at* ¶ 5, Ex. 2 are copies of numerous registrations² in food classes where the term "homemade" is not disclaimed, including by way of example, the following:

<u>Reg. No.</u>	<u>Mark</u>	<u>Goods</u>
3080910	Make Every Day Homemade	[Large variety of food products in class 30]
3341637	Homemade Family (and design)	Organic snacks, namely, cooked vegetables and fruits
3341636	Homemade Kids (and design)	Organic snacks, namely, cooked vegetables and fruits
3211844	Hot & Hearty Like Homemade	Frozen meals consisting primarily of meat, poultry or vegetables.
2901806	Legendary Name! Legendary Taste!	Goetta, namely sausage-blend
3558965	Homemade Flavor Since 1923	Soup and broth
3078806	5 Minutes to Homemade	Pudding
3040766	Looks Like Homemade. Tastes Like Homemade.	Chili
2984977	It Tastes Homemade Because We Still Make It That Way	Frozen prepared foods [in classes 29 and 30]
3096313	Headstart on Homemade	Refrigerated or frozen potatoes.
2939597	Homemade. Made Easy.	Mixes for pancakes, waffles and bakery goods
3860430	Bringing Homemade Home Again	Pasta sauces
3755656	Homemade Taste Every Time	Instant potatoes, processed potatoes

² The exhibit is comprised of forty registrations in classes 29 and 30 and fifteen additional registrations for goods or services directly related to food products (e.g., restaurant services, cookbooks, etc.).

3605373	Momma Reiner's Fudge Homemade In a Little Kitchen etc.	Fudge
3687046	Homemade Gourmet Season 'N' Steam	Dry seasoning mixes
3842080	Homemade Happiness	Tortillas
3571810	We Make "homemade" easy!	Chocolate
3618284	homemade gourmet (and design)	Soups, coffees, teas, etc.
3492137	hip & homemade	Caramels; toffee
3719170	The Taste of Homemade Without All The Work	Frozen, prepared and packaged sauces etc.
3510730	Yo Mama's BBQ Sauce / It's Homemade Good	Barbeque sauce
3985953	Homemade In The Shade	Ice cream
2938656	Homemade Has Met It Match	Dehydrated potatoes and mashed potato mix
2788152	Jenny's Country Kitchen, Making Homemade A Little Easier	Gourmet dry mixes for bakery goods
2506581	Homemade With A Little Help	Baking Mixes
2339275	Bringing Homemade Home Again	Processed fruit and vegetables etc.
2059019	Homemade Goodness . . . Away From Home	Baked goods, namely cakes, muffins etc.
2250931	Homemade In Minutes	Soups and dried soup mixes
2130642	Close To Homemade Without All The Fat	Bottled gravy
2130122	Make Homemade Easy	Vegetable based soup mix
2133741	Barbara & Virginia's Country Kitchen Convenience That Tastes Homemade	prepared meats and vegetables
1886241	Pastaio Brand Tradition of	Pasta

Homemade Quality (etc.)

1793249	Rao's Homemade It's The Sauce	Pasta sauces, seafood sauce, etc.
1644529	Hawkins Homemade	Applesauce
1586959	Hans Kissle The Taste of Homemade Goodness	Salad, macaroni, rice
1449926	Homemade Taste. Its In There	Prepared dishes, sauces, etc.
1311327	Start Your Day The Homemade Way	Sandwiches made with Biscuits
1057834	The Closest Yet To Homemade	Pies
1875431	Home-made, Made Easy!	Mixes for bakery goods

Obviously, the Trademark Office has no "routine" requirement of a disclaimer of the term "homemade."

As stated in *Societe Civile Des Domaines Dourthe Freres v. S.A. Consortium Vinicole De Bordeaux Et De La Gironde*, 6 USPQ2d 1205 (TTAB 1988):

Fraud implies some intentional deceitful practice or act designed to obtain something to which the person practicing such deceit would not otherwise be entitled. . . . Intent to deceive must be "willful". If it can be shown that the statement was a "false misrepresentation" occasioned by an "honest" misunderstanding, inadvertence, negligent omission or the like rather than one made with a willful intent to deceive, fraud will not be found. Fraud, moreover, will not lie if it can be proven that the statement, though false, was made with a reasonable and honest belief that it was true or that the false statement is not material to the issuance or maintenance of the registration. It thus appears that the very nature of the charge of fraud requires that it be proven "to the hilt" with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party. *Smith International, Inc. v. Olin Corp.*, 209 USPQ 1033 1043-44 (TTAB 1981), citations omitted.

Goya had no intention of defrauding the U.S. Trademark Office when it filed its application for CASERA and translated the term as "homelike," which translation is nevertheless an apt translation of the term "casera." See Colon Decl. ¶¶ 13-16.

(ii) Misdescription of Goods

The Applicant's claim in this regard is based upon ¶¶ 30 and 31 of its First Counterclaim, wherein Applicant asserts "upon information and belief" that Goya "was not using CASERA on any processed vegetable at the time" it filed its original application and at the time it filed its 8&15 affidavit "or was using the mark on only one 'processed vegetable'"

As demonstrated in Section A(iii) below, Goya was using the mark on processed vegetables at the time it filed its application and at the time it filed its Section 8&15 Affidavit.

Regarding the alleged misdescription of goods, the Applicant appears to be asserting either that canned processed beans are not "processed vegetables" or that Goya was using the mark on only "one processed vegetable."

Regarding the first assertion, beans are considered a vegetable in the food industry. *See* Colon Decl. ¶ 17 and Ex. 6 thereto (printouts from various sources evidencing that beans are considered vegetables).

Regarding the second assertion (i.e. "one processed vegetable") the Board is referred to paragraphs 6-8 and 10 and Exhibits 1 and 2 of the Colon Declaration regarding Goya's use of the mark on a variety of products including more than one variety of canned processed beans at the time of filing the original application and at the time of filing its Section 8&15 affidavits. The declaration also includes annual sales figures in 2008 (the year the 8&15 affidavit was filed) showing annual sales of CASERA products (primarily on canned processed beans) in excess of \$9.8 million. *Id.*, at ¶ 10.

Even if Goya had used the mark on only one type of canned beans at any of the times referred to by the Applicant, reciting its goods as "processed vegetables" rather than "processed vegetable" is a hyper-technical reading of the description and would not arise to the level of a

valid claim of intentional fraud. *See, Tri-Star Marketing LLC v. Nino Franco Spumanti S.R.L.*, 84 USPQ2d 1912, 1914-15 (TTAB 2007):

Fraud in procuring a registration occurs when an applicant knowingly makes false, material representations of fact in connection with an application to register or, in the case of maintaining a registration, when a registrant makes false, material representations of fact in connection with an affidavit of continued use under Section 8. *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986). A party making a fraud claim is under a heavy burden because fraud must be proved to the hilt with clear and convincing evidence, leaving nothing to speculation, conjecture, or surmise. Any doubt must be resolved against the party making the claim. *Sinclair Oil Corp. v. Sumatra Kendrick*, ___ USPQ2d ___ (TTAB, Opp. No. 91152940, June 6, 2007).

And, *see Id.*, at 1916:

In the present case, inasmuch as respondent could have legitimately obtained a registration covering the identification of goods reading “wines” (even though it was using the mark on only “sparkling wines”), respondent has not obtained any rights to which it was not entitled.

In any event, there was no misrepresentation of goods in Goya’s registration. The Applicant’s assertions are meritless.

(iii) Non-use At Time Of Filing the Original Application and at the Time of Filing Goya’s 8&15 Affidavits

(a) Time of Filing Application

Attached to the Colon Declaration as Exhibit 1 is copy of a “Stock Status Report” dated December 5, 2002 from Goya’s files pertaining to the CASERA products. The report was generated by Mr. Colon in 2002 and evidences that Goya was then selling a number of CASERA brand products, including without limitation, capers (alcaparras), canned tomato sauce (salsa de tomate), canned red beans in broth (coloradas in caldo), canned pink beans in broth (rosadas en caldo), canned white beans in broth (blancas en caldo), canned black beans (habichuelas negras),

canned garbazos in broth, canned kidney beans (frijoles), canned pinto beans (pintas), canned lentils (lentejas), and olives (aceitunas). Mr. Colon also states upon personal knowledge that the above listed goods (which include a variety of CASERA brand canned beans) were being sold before and at the time of filing of the original application in 2002. *See* Colon Decl. ¶¶ 6 and 7.

(b) Time of Filing 8&15

Mr. Colon also affirmed upon personal knowledge (including representative examples of sales records) that Goya was selling a variety of canned beans and other goods bearing the CASERA mark at the time Goya filed its Section 8&15 affidavit in 2008, and that sales in 2008 exceeded \$9.8 million. *See* Colon Decl. ¶¶ 8 and 10 and Ex. 2 thereto.

While vague, it appears that the Applicant is making an issue over the specimen filed by Goya with its 8&15 affidavit, stating that the specimen is “exactly the same product label that was submitted as a specimen of use in connection with the application.” *See* paragraph 29 of Applicant’s First Counterclaim.

Morehouse Manufacturing Corporation v. J. Strickland and Company, 160 USPQ 715 (CCPA 1969) is instructive on the matter:

. . . the only purpose of attaching a label to a section 8 affidavit is to support the allegations of continuing use with some tangible evidence. In this case on the record before us, there can be no question that appellee was continuing its use of “Blue Magic” on the same article for which it was initially registered at the time the affidavit was filed and that the allegations of continuing use were true. The mark shown on the label attached to the affidavit was substantially the same mark in use on the later label actually being used; a casual observer might well say it was the identical mark. All the statute requires is an affidavit “showing that said mark is still in use,” making no reference to submission of specimen labels. The affidavit here submitted, in the words “a specimen of the mark as now actually being used,” (emphasis ours) cannot *clearly* be said to be false because the mark on that label is substantially the *mark* as then being used, even if the label was not. If not clearly false, it cannot be said to result in fraud. . . . Given the fact of continuing use, from which practically all of the user’s substantive trademark rights derive, nothing is to be gained from and no

public purpose is served by cancelling the registration of a technically good trademark because of a minor technical defect in an affidavit. *Id.*, at 719 – 720.

Goya was using the mark and selling CASERA brand canned beans at the time it filed the Section 8&15 affidavit. As such, Goya's Section 8 affidavit of continuing use is true and valid.

B. Applicant's Second Counterclaim – Abandonment/Non-Use

At paragraph 32 of its Second Counterclaim, the Applicant alleges that:

Upon information and belief, [Goya] has not used CASERA on “processed vegetables” for more than three years, or, in the alternative, has not used CASERA on “processed vegetables” within the last three years and does not intend to resume use.

Sales of CASERA brand products (including primarily sales of processed canned beans) over the past three (3) years are well in excess of \$25 million. *See* Colon Decl. ¶ 10. Attached to the Colon declaration as Exhibit 3 is a copy of a current promotional flyer and also a screen shot from the casera website showing the current line of CASERA products, which, as shown in the exhibit, includes *inter alia* canned processed beans. Also attached to the Colon declaration as Exhibit 4 are copies of downloads from on-line third party retailers showing that they currently offer CASERA brand products for sale. Finally, as affirmed by Mr. Colon, since the date Goya purchased the CASERA mark in 1993, Goya “has never abandoned or ceased use of its CASERA mark and has no intention to discontinue use of the mark.” *See* Colon Decl. ¶ 13. *See* also Colon Decl. ¶ 10 (Annual sales volume for CASERA products from 2007 to the present).

The relevant definition/test for abandonment, as set forth at 15 USC §1127 is:

Abandonment of mark. A mark shall be deemed to be “abandoned” if . . .

When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. “Use” of

a mark means the bona fide use of such mark made in the ordinary course of trade, and not merely to reserve a right in a mark.

As evidenced by the Colon Declaration, Goya has used the CASERA mark for, *inter alia*, the past three (3) years; Goya has not discontinued use; and Goya has no intent to discontinue use.

Goya takes issue with the Applicant's claim. The Applicant's counterclaim for abandonment was filed by the Applicant on May 23, 2011. A simple Google search for CASERA brand beans in May of 2011 would have immediately advised the Applicant that such goods were being sold by a variety of on-line third parties. A simple call to Goya would have confirmed such sales. A visit to the Casera website at www.caserapr.com would have confirmed that the products were being offered for sale. In fact, the Applicant could have then purchased such products. See Rannells Decl. ¶ 5 and Ex. 3 thereto and Colon Decl. ¶ 9 and Ex. 3 thereto (*Internet Wayback Machine* archived website screen shots from 4/27/2010, 2/24/2011, and current home page; also third party website evidence from 1/25/2003, 12/19/2011, and current).

The Applicant's Second Counterclaim is alleged on "information and belief." That allegation presumes either that the Applicant was in possession of relevant information or that it searched for such information with no results. In response to the Counterclaim, Goya responded by denying the allegations and by asserting the following as an affirmative defense:

2. Upon information and belief, Applicant failed to make reasonable inquiry and Applicant lacks information and has no valid basis for its alleged belief that GFI has abandoned its CASERA mark in connection with "processed vegetables" and had no information and had no valid basis for its alleged belief at the time Applicant filed its Second Counterclaim.

As use of the CASERA mark on a variety of food products was open and readily available at the time Applicant filed its counterclaim and for *inter alia* the three years prior

thereto, and has been available continuously since then, the Second Counterclaim should be dismissed as it lacks any valid basis.

C. Applicant's Third Counterclaim – Genericness

At paragraphs 36 and 43 its Counterclaims, the Applicant alleges that:

36. Upon information and belief, “casera” and “casero” are generic or merely descriptive terms when used in connection with food products.

43. Opposer's mark CASERA is generic as applied to Opposer's “processed vegetables,” and consequently Registration No. 2,740,494 should be cancelled.

To the extent Applicant is claiming, as indicated in paragraph 36 of its Counterclaims, that the term “casera” is merely descriptive, it fails to state a claim upon which relief can be granted. Goya's mark is incontestable. *See* 15 U.S.C. § 1065.

To the extent Applicant is claiming that the term “casera” is (or has become) generic as applied to processed vegetables or processed canned beans, the claim is meritless and lacks any valid basis. Goya incorporates herein by reference, its arguments above concerning the meaning of the term “casera” including the dictionary definitions, the historical records of third party registrations (including translations) of the term “casera” or “casero,” and third party registrations containing the term “homemade” without disclaimer.

As stated in *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 228 USPQ 528, 530 (Fed. Cir. 1986):

A generic term is the common descriptive name of a class of goods or services . . . The generic name of a thing . . . [citing cases as well as *McCarthy on Trademarks and Unfair Competition*]. . . . The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of

goods or services in question. [Citing cases]. Determining whether a mark is generic therefore involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?

A prime example of what does not constitute a generic mark can be found in *Maremont Corporation v. Air Lift Company*, 174 USPQ 395, at 397 (CCPA 1972) wherein the CCPA ruled that the word-mark LOAD-CARRIER for load-supporting and damping units for automobiles, automobile trailers, and small trucks was not generic, stating therein that “The word ‘LOAD-CARRIER’ is no doubt highly *suggestive* of the function of the class of goods produced by both parties, but it is equally suggestive of many other things—e.g., wheel barrows, dump trucks, freight cars, steamships, and elevators.” [Emphasis in the original]. Being suggestive of a function of a class of goods is insufficient to render a term generic.

As stated in the TMEP at §1209.01(c), “Generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the goods or services.” See also, *In re Am. Fertility Soc’y*, 188 F. 3d 1341, 1346, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999).

One’s imagination cannot be stretched far enough to claim that the purchasing public understands the term “casera” primarily as the common or class name for “processed vegetables” or for “canned processed beans.” As stated by Mr. Colon who is bi-lingual and has well over 50 years of experience in the food industry and fifty-four years with Goya:

The term “casera,” regardless of how the Applicant would prefer to translate the mark, is not and never has been a common descriptive name for “processed vegetables” or “canned beans” and would not be perceived as such by the relevant public. To my knowledge and after searching our own library, there does not exist any dictionary that defines “casera” as being generic of “processed vegetables.” Based upon my many years of marketing experience in the food industry, I can state that the relevant

public does not use the term “casera” to refer to the relevant genus of goods, namely “processed vegetables.” In fact, the term (even when used in a phrase like “sabor casera”) is merely suggestive of something pertaining to the home, or something domestic, or something reminiscent of home cooking, or when viewed as a noun is a reference to a household or to a landlord or landlady, as the actual dictionary definitions indicate. At most, the term would merely be suggestive of the quality of a food product. No one picking up a can of processed kidney beans would think the same were “homemade” in the literal sense of the word.

Over the many years of our use of the CASERA mark we have never received a single communication from a consumer that would indicate that a consumer was confused or under the impression that our CASERA mark was a generic term for any of the goods sold under our CASERA mark.

See, Decl. Colon, ¶¶ 18 and 19.

The Applicant’s Second Counterclaim is alleged on “information and belief.” That allegation presumes that the Applicant was in possession of relevant supporting information and that Applicant had a bona fide belief that the alleged claim of genericness has a legal basis. In response to the Applicant’s Third Counterclaim, Goya responded by denying the allegations and by asserting the following as an affirmative defense:

3. Upon information and belief, Applicant’s Third Counterclaim is not warranted by existing law or by a nonfrivolous argument and lacks any legally valid, bona fide or meritorious basis and Applicant and Applicant’s attorneys are aware that the Third Counterclaim lacks any legally valid, bona fide or meritorious basis and were aware of same at the time of filing the Third Counterclaim.

Applicant’s Third Counterclaim (genericness) should be dismissed as it lacks any bona fide or meritorious basis.

WHEREFORE, Goya Foods, Inc. prays that Applicant's First, Second and Third Counterclaims be dismissed in their entirety.

Dated: December 11, 2012

Respectfully submitted,
BAKER AND RANNELLS, P.A.

By 

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of **OPPOSER/COUNTERCLAIM DEFENDANT'S MOTION FOR SUMMARY JUDGMENT** was forwarded by first class postage prepaid mail by depositing the same with the U.S. Postal Service on this 11th day of December, 2012 to the attorney for the Applicant/Counterclaim Plaintiff at the following address:

Paul. S. Owens, Esq.
Paul Owens & Associates
P.O. Box 15310
Atlanta, Georgia 30333
psowens@bellsouth.net


John M. Rannells

1 **CERTIFICATE OF SERVICE**

2 I hereby certify that a copy of the foregoing APPLICANT'S ANSWER TO NOTICE OF
3 OPPOSITION was sent to attorneys for Opposer this day by first class mail, postage prepaid, to
4 the following address:

5
6 Stephen L. Baker
7 Ryan A. McGonigle
8 Baker and Rannells PA
9 575 Route 28
10 Raritan, NJ 08869

11 Dated: July 2, 2013

12 
13 B.C. Dunne

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